

REMARKS

Applicant is in receipt of the detailed Office Action mailed July 25, 2003. Claims 1-8 and 13-16 are rejected. Applicant requests reconsideration of the remaining claims in view of the following remarks, and entry of these remarks into the record as a prelude to an appeal, if needed.

35 USC § 103 Rejection

The Examiner rejects Claims 1-8 and 13-16 under 35 USC §103 as being unpatentable over Hisao et al (JP 10209467). The Examiner states that the thickness of the gate insulating film 4 *can* be chosen to be thicker than the thickness of the gate electrode. The Examiner also states that overlapping ranges in the cited reference create a *prima facie* case of obviousness. Applicant traverses the rejection. MPEP 2144.05 states:

“Applicants can rebut a *prima facie* case of obviousness based on overlapping ranges by showing the criticality of the claimed range. “The law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims. . . . In such a situation, the applicant must show that the particular range is critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range.” In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). See MPEP Section 716.02 - Section 716.02(g) for a discussion of criticality and unexpected results.”

Merely because it is possible for a claim limitation to exist in a cited reference does not necessarily mean that a cited reference actually teaches that claim limitation. This is exactly the case here. The Examiner asserts that it is *possible* for the cited reference to disclose that the gate insulating film is thicker than the gate electrode. The support for this reasoning is the Examiner’s assertion of overlapping ranges in the cited reference and the claimed invention. However, what is overlooked is that the cited reference completely fails to present any reasoning whatsoever as to why one would adjust the disclosed relationship between the gate insulating film and the gate electrode in the cited reference to arrive at Applicant’s claimed invention. In fact, the reference is completely silent as to any relationship whatsoever between the gate insulating film and gate electrode as well as any reasoning as to why one would provide any specific relationship between the gate insulating film and the gate electrode. Therefore, to the extent that the Examiner asserts that a *prima facie* case of obviousness is presented by virtue of this alleged overlapping range, such a

*prima facie* case is properly rebutted by Applicant's express recitation of significant advantages of its claimed relationship, especially in view of the failure by the cited reference to present any reasoning as to why such a range relationship would exist. Accordingly, for the reasons set forth above, Applicant submits that Claims 1 and 5 and all claims depending therefrom are in a condition for allowance.

CONCLUSION

For at least the above reasons, Applicants respectfully submits that the present invention, as claimed, is patentable over the prior art. If the Examiner has any issues which he believes can be expedited by a telephone conference, he is encouraged to telephone the undersigned Representative. All objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance, and a Notice to that effect is earnestly solicited. It is believed that any additional fees due with respect to the filing of this paper should be identified in any accompanying transmittal. However, if any additional fees are required in connection with the filing of this paper that are not identified in any accompanying transmittal, permission is given to charge Deposit Account 18-0013 in the name of Rader, Fishman & Grauer PLLC.

Respectfully submitted,

Dated: October 24, 2003

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